REMARKS

Applicants have read and considered the Final Action dated April 14, 2006, and the references cited therein. Claims 1, 16, 25, 40, 49, 62 and 68 have been amended. Claims 15, 39 and 61 have been cancelled without prejudice. Claims 1-12, 14, 16-36, 38, 40-59 and 62-68 are pending.

Claim 68 was objected to for improper dependency. Claim 68 has been amended to reflect that it depends from claim 49. Applicants assert that the object is overcome.

Independent claim 1 has been amended and clarifies the invention. The subject matter of former claim 15 has been incorporated therein to specify that the "securely associating" of step c) involves sub-steps of generating a secure process authentication code uniquely representing the process log and embedding this code in the document as signed.

In his "Response to Arguments" in the above-mentioned Final Action, it was stated that it is unclear from the claim language and the description what constitutes a "secure association". Applicants assert that former claim 15, now incorporated into claim 1, gives clear indications as how the process log is securely associated with the document as signed, that is, by embedding a secure process authentication code in the document as signed. Claim 16 further specifies that the secure process authentication code is a hash of the process log. This aspect of the invention is also discussed at length in the specification, for example at page 8, lines 3-18.

Former claim 1 was rejected as being anticipated by U.S. Patent No. 6,091,835 to Smithies et al. (hereinafter SMITHIES). Former claim 15 was also rejected as being anticipated by SMITHIES.

Applicants would first like to point out that SMITHIES does not provide for the actual application of a signature on a document. The focus of SMITHIES is on recording of evidence related to an "affirmation" of an electronic document and the secure storage of this evidence in a transcript object, not in the document itself. SMITHIES therefore considers the expression "signing a document" as an affirmation act, not the literal application of a signature on the document. This is evident from a reading of the entire specification of SMITHIES. The first paragraph of the "SUMMARY OF THE INVENTION" for example summarizes this concept:

> *"The present invention presents a method and system for recording a detailed record or "transcript" of the acts, events and circumstances related to a party's electronic affirmation of a document, transaction or event. The system directs a*

"ritual" or "ceremony" of affirmation--an affirming process--whereby the party affirming the document is required to undertake a series of steps in order to successfully complete the affirmation; thus participation in the ceremony must take place before an affirmation will be accepted. The exemplary embodiment stores the detailed record in a secure data object, a transcript object. This data object will not be created and stored, and thus the document transaction or event will not be affirmed, until each of the required steps is carried out." (Column 7 lines 10 to 23)

Indeed, in a thorough review of the specification of SMITHIES, Applicants could not find *any* reference to the application of a signature on the document itself. Such a step has actually been found incompatible with the process of SMITHIES, as it is important for this process for the document on which affirmation is sought remains unmodified after the affirmation ceremony has taken place, as any subsequent changes thereto would invalidate the whole process. Rather, SMITHIES relies on the transcript object to view and verify that document has not been tampered with and that the e-signature corresponds to the signer.

It is therefore submitted that SMITHIES does not teach a "method for applying a legally enforceable signature of a user on an electronic document", as provided by the present invention, and that it does not teach of a step of "applying said signature of the user on said document", as specified in substep b) iii) of claim 1.

Regarding former claim 15, the Office Action contends that SMITHIES teaches a step of generating a secure process authentication code (a checksum) uniquely representing a process log (which is identified as the transcript object of SMITHIES) as explained in column 14, lines 22-39 of this reference. The Office Action also contends that SMITHIES teaches, at column 14, lines 5-21, of embedding the checksum in the document assigned thereby securely associating the process log in the document.

Applicants strongly traverse these contentions.

The two passages of SMITHIES quoted in this regard are extracted from a section of SMITHIES detailing the six (6) evidence groups contained in the transcript object of SMITHIES (see column 12 lines 49-50), which can be used to prove intent of the related transaction. Column 14, lines 22-39 concerns the fifth one of those evidence groups and this paragraph is entitled "Evidence to link the specific client application to the information" (emphasis added).

The transcript generator module creates a checksum of the transcript object using a key supplied by the client application. This key-created checksum provides a direct identifying link between a specific client application and a given transcript object and allows somebody using that same specific client application to verify if the transcript object has been tampered with after the fact. It does not create a link between the document itself and the transcript object.

Column 14, lines 5-21 of SMITHIES concerns the fourth evidence group listed and the paragraph in question is entitled "Evidence to verify integrity of the Provisions or Undertakings of the document, Transaction or Statement". It refers to making a hash or checksum of the document presented for affirmation. This is done in order to show the integrity and accuracy of the contents of the document, and ensures that it has not been modified after the affirmation. This hash could not be said to be a hash of the process log. In addition, as with all of the evidence groups detailed in this section of SMITHIES, this hash of the document is stored in the transcript object.

Nowhere in these passages of SMITHIES or anywhere else in this reference is there a mention of embedding any such evidence in the document itself. Moreover, embedding any information in the document after signature thereof through the process of SMITHIES would invalidate the document in question since later creating a hash of this document would provide a result that would not match the one way hash prepared at column 14, lines 12 and 13. The embedding of a process authentication code representative of the process log inside the signed document itself is therefore in direct contradiction with the teachings of SMITHIES.

In effect, the present invention and SMITHIES provide opposite approaches to the management of evidence. SMITHIES creates a one way hash of a document and imbeds it in the transcript object (a type of process log according to the Office Action), whereas the present invention takes a hash or other authentication code of the process log and imbeds it in the document as signed. The approach of the present invention therefore creates a link to the signing ceremony within the signed document itself, which is made available to the user(s) having signed it or other users requiring access to the signed document. This is relevant to the present invention as the desired end-result of the method of claim 1 is the signed document itself; the same approach would make no sense for SMITHIES as the desired end-result of his invention is the transcript object; the actual document is not affected or transformed by the affirmation process.

Embedding the process log authentication code in the signed document provides for using the e-signed document and to also have evidence that it corresponds to the process log without actually having a copy of the process log. This is very advantageous since distributing the process log (or transcript object) in addition to the e-signed document can be very cumbersome at best and highly impractical from most business processes. In the approach of the present invention, the signed document can be distributed to all parties who need a copy as evidence of the transaction and have the ability to bring it to court or to any relevant proceeding, where it will represent the best evidence available since it can also be related to the process log. This is to be contrasted with the Smithies approach where the entire transcript object must be distributed to each party in addition to the signed document in order for them to have the best evidence available, since the document by itself does not provide a secure association to the transcript object.

In view of the above, it is therefore evident that the subject matter of claim 1 is not taught or suggested by SMITHIES and is contrary to its teachings and the Examiner is therefore respectfully requested to withdraw his rejection with regard thereto.

As independent claims 25 and 49 were modified in a manner similar to claim 1, they are also considered new and non-obvious over the cited prior art for at least the same reasons discussed above. As all other pending claims are dependent on one of the above-mentioned independent claims, the rejections with regard thereto are considered moot. Applicants assert that the claims patentably distinguish over SMITHIES and/or any other prior art or combination thereof.

In view of the above amendments and remarks, Applicants respectfully requests a Notice of Allowance. If the Examiner believes a telephone conference would advance the prosecution of this application, the Examiner is invited to telephone the undersigned at the below-listed telephone number.

Respectfully submitted,

MERCHANT & GOULD P.C.
P.O. Box 2903
Minneapolis, Minnesota 55402-0903
(612) 332-5300

Date: 10/13/06

Gregory A. Sebald
Reg. No. 33,280
GAS:PLSkaw